

4-3-98

(394)

103 APR 1998

Hearing:  
March 5, 1997

**THIS OPINION IS CITABLE  
AS PRECEDENT OF  
THE T.T.A.B.**

6/9/98

Paper No. 42  
RFC

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Goodyear Tire & Rubber Company  
v.  
Vogue Tyre & Rubber Company

Opposition No. 91,352

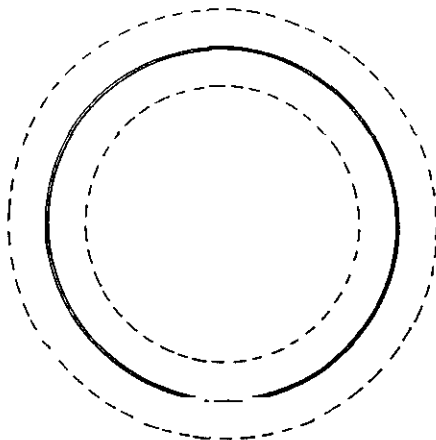
Albert Robin and Howard B. Barnaby of Robin, Blecker, Daley  
& Driscoll for The Goodyear Tire & Rubber Company.

Harold V. Stotland of Emrich & Dithmar for Vogue Tyre &  
Rubber Company.

Before Rice, Simms and Cissel, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

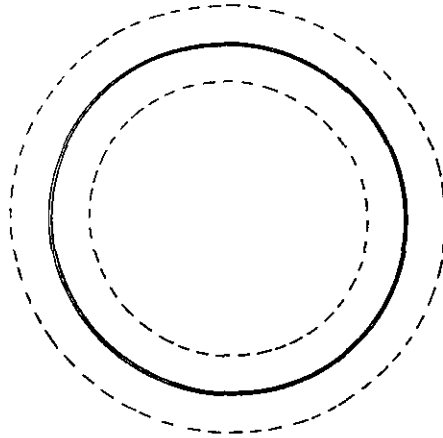
On December 23, 1991, Vogue Tyre & Rubber Company,  
(hereinafter "Vogue"), applied to register the mark shown  
below



**Opposition No. 91,352**

on the Principal Register for "automobile tires," in Class 12. The application described the mark as consisting of "a gold annular stripe approximately in the center of the sidewall (sic) of black sidewall tires." The basis for the application was applicant's claim of use in commerce since October 22, 1991.

The applicant claimed ownership of Registration No. 1,166,422. The mark in that registration is shown below.



The claimed registration issued on the Principal Register to Vogue on August 25, 1981, and a combined affidavit under Sections 8 and 15 of the Act was subsequently filed. The goods listed on the registration are also "automobile tires." Use since July of 1966 is claimed. The registration also provides the following explanation:

"The drawing is lined for the color gold. In the drawing of the mark, the matter shown by the broken lines is not part of the mark and no claim is made to it. The matter shown by the broken lines serves only to portray the outline of a tire, showing the manner in which the mark is displayed. The mark consists of a gold annular band located between the white annular

**Opposition No. 91,352**

band on a white sidewall tire and the tread of the tire."

In the instant application, the Examining Attorney apparently accepted applicant's claim of ownership of Reg. No. 1,166,422, but in his first Office Action, he refused registration under Sections 1, 2 and 45 of the Lanham Act because the matter which is now sought to be registered was found to be "ornamental." Further, he stated that it "does not function as a trademark." Applicant was advised that it could seek registration under Section 2(f) of the Act

"by claiming acquired distinctiveness through ownership of U.S. Registration 1,166,422. To do so, the applicant must provide a statement that the mark has become distinctive of the goods as evidenced by ownership of U.S. Registration No. 1,166,422 on the Principal Register for the same mark for related goods or services."

Applicant adopted the suggestion of the Examining Attorney and amended the application to claim distinctiveness by virtue of ownership of the claimed registration, and also amended the description of the mark to state that the dotted lines are not parts of the mark. The Examining Attorney then passed the application to publication.

Following publication in the Official Gazette, a timely notice of opposition was filed by The Goodyear Tire & Rubber Company (hereinafter "Goodyear"), on April 26, 1993. As grounds for opposition, opposer alleged that prior to applicant's alleged date of first use, Goodyear had used

**Opposition No. 91,352**

annular stripes or bands of various colors, including yellow or gold, as ornamentation on the sidewalls of its automobile tires; that other tire manufacturers had also done so; that the prior registration claimed by applicant, Reg. No. 1,166,422, did not evidence rights in the mark now sought to be registered, especially in view of the fact that applicant's amendment to describe its mark there as a gold band on a whitewall tire was the result of express agreements dated March 31, 1981 and April 8, 1981, wherein, in order to avoid litigation with opposer, applicant had agreed to limit its claim to the gold band between the whitewall and the tread on a whitewall tire and not to object to opposer's use of a gold band on a whitewall tire between the whitewall and the tire bead. Opposer further asserted that registration to applicant of the matter now sought to be registered would be inconsistent with the rights of opposer and others in the automobile tire industry to use yellow or gold annular stripes as ornamentation on the sidewalls of their products; that a gold annular stripe in the center of a black sidewall tire does not identify the source of applicant's tires and distinguish them from tires made by others; and that applicant's claim of distinctiveness is not established by the record in the application, including applicant's claim of ownership of its prior registration for a gold stripe on a whitewall tire.

**Opposition No. 91,352**

Applicant's answer to the notice of opposition denied the allegations set forth therein.

Applicant's motion to dismiss was denied by the Board, as was opposer's later-filed motion for summary judgment. A trial was conducted in accordance with the Trademark Rules of Practice. Testimony was taken by both parties and evidence was made of record in support of each party's position. Briefs were filed, and an oral hearing was conducted before the Board on March 5, 1997.

Opposer's record consists of the testimony of Kenneth Williams, opposer's trademark attorney; Charles Roberts, the former Chief Engineer at Goodyear; John Kelsey, President of Kelsey Tire, Inc.; Lowell Eckart, the Uniroyal Brand Manager of Michelin North America; and Joseph Coker, President of Coker Tire Company, Inc. Forty-five exhibits to this testimony were introduced into the record. Eight more were made of record by stipulation, and further, opposer relied on applicant's responses to opposer's interrogatories and requests for admissions, an advertisement from a 1966 magazine, and the file history of the opposed application.

Applicant took the testimony of its President, Joel Fisher, and its Executive Vice-President, Garry Goyak. Forty-nine exhibits were introduced in connection with this testimony. Applicant also made of record copies of its

**Opposition No. 91,352**

prior registration, Reg. No. 1,166,422, and the written agreement from 1981 that relates to it.

Based on careful consideration of the record in this proceeding, we conclude that applicant is not entitled to the registration it seeks. Applicant has not established that its use of gold bands on the sidewalls of blackwall automobile tires has resulted in consumer perception of this ornamental feature as a trademark for applicant's tires, identifying their source and distinguishing them from similar goods made by others. Neither the existence of Reg. No. 1,166,422, nor applicant's rather limited use and promotion of gold bands on its blackwall tires, in view of previous uses by others in the field, establish that applicant has acquired distinctiveness in this feature of its products.

The 1981 agreement does not dictate a different conclusion. Notwithstanding applicant's contentions to the contrary, that agreement related to the placement of gold bands on whitewall tires, not blackwall tires. The agreement apparently resolved opposer's concerns in 1981 with respect to applicant's claim then, and it settled the issue of where opposer could put gold stripes on its own whitewall tires without running afoul of applicant's claim, but in view of the past use by opposer and others of colored bands on tires, neither the agreement nor the registration

it permitted is an appropriate basis for concluding that applicant has developed secondary meaning in gold bands on blackwall tires.

The record shows that a number of tire manufacturers, including both applicant and opposer, have used colored annular stripes on their tires, and that such use has been considered to be ornamental. Goodyear has used white, gold, red, gray, blue and orange on annular stripes on its tires. Mr. Roberts testified that such colors were used for the purpose of visual appeal and showroom impact, i.e., for the esthetic appeal the colors created. Mr. Kelsey, who sells tires for vintage automobiles, testified that for most of this century, various colors have been used on sidewalls by tire manufacturers, including gold, red, brown, blue, white and green. His company still sells tires with gold bands on their sidewalls. Mr. Coker testified that he has sold tires with gold stripes on the sidewalls made by a number of different manufacturers, including B. F. Goodrich, Firestone, Michelin and U.S. Royal.

The advertisements and catalog excerpts of record in this case are in accord with the testimony that these gold bands are ornamental and that several different manufacturers have produced tires with gold bands alone or in combination with whitewalls. Because the use of gold bands on tires has been relatively widespread, and such

**Opposition No. 91,352**

stripes are clearly ornamental in nature, we are not persuaded that applicant's use of them on blackwall tires is perceived as a source indicator by the relevant purchasing public. Applicant argues that the evidence and testimony relating to use by others of gold bands on blackwall tires relates only to use in the past, and that the record is without persuasive evidence that such tires are now being produced and sold by anyone other than applicant. That the record is not probative of widespread use at this time by anyone, including applicant, is not persuasive of the proposition that colored bands are perceived as trademarks, rather than ornamental in nature. The widespread use of such stripes by others, even if such use was largely in the past, shows that current customers for tires have no reason to understand that these colored bands are now trademarks, rather than merely ornamentation, as they have always been.

Applicant's modest sales and promotion of its blackwall tires with gold bands are not proof that gold bands have come to indicate the source of applicant's tires. The period for which we have evidence and testimony about applicant's blackwall tires is from 1992, the year after applicant began using gold stripes on its blackwalls, through the year 1996. Although the evidence and testimony in this regard is confidential and accordingly will not be discussed in detail in this opinion, we agree with opposer



**Opposition No. 91,352**

that when the information concerning applicant's sales of tires with both a gold stripe and the word mark "VOGUE" on the sidewall is distinguished from the information about sales of blackwall tires with only gold bands, such sales have declined to the point where they are miniscule.

The evidence and testimony concerning applicant's sales and promotion of tires using gold bands between the whitewalls and the treads of the tires simply do not establish that gold annular stripes on blackwall tires have become distinctive indicators of their source. In the same sense, the registration stating that on whitewall tires, a gold stripe between the whitewall and the tread identifies applicant as the source is not persuasive that a gold stripe on a black sidewall tire is also applicant's trademark. This is particularly so in light of applicant's express agreement that opposer may sell whitewall tires with gold stripes, as long as the gold stripe is on the inside of the tire, between the whitewall and the bead, rather than on the outside of the tire, between the whitewall and the tread.

Notwithstanding applicant's testimony and argument to the contrary, the 1981 agreement is very clear. Its plain meaning is that opposer will be allowed to put the gold band inside the whitewall, whereas applicant will put it outside the whitewall. To contend that the agreement speaks to the

**Opposition No. 91,352**

rights of the parties with respect to blackwall tires borders on the disingenuous.

In a similar sense, it was not appropriate for the Examining Attorney to suggest that applicant could base a claim of distinctiveness under Section 2(f) of the Act on the ownership of Reg. No. 1,166,422. While under Trademark Rule 2.41(b), ownership of a registration of the same mark may be accepted as evidence of distinctiveness, as discussed above, the drawing and text of that application and the resulting registration, as well as the 1981 agreement between the parties which caused opposer to withdraw its objection to registration, make it clear that the mark there consisted of the positioning of a gold band relative to a white sidewall on a tire. Because the mark depicted and described in the instant application is alleged to consist only of a gold band on the side of a blackwall tire, reference to the band's position relative to the white sidewall of a tire is not applicable, so the two "marks" are not the same. Trademark Rule 2.41(b) therefore does not come into play, and the prior registration cannot be used to establish the distinctiveness applicant claims for its second "mark."

Opposer's claim that applicant had a duty to disclose to the Patent and Trademark Office the fact that the mark in Reg. No. 1,166,422 was not the same mark sought to be

**Opposition No. 91,352**

registered with the instant application is without any logical or legal support. Applicant simply adopted the suggestion of the Examining Attorney and included the reference with the claim under Section 2(f). Opposer has not established that the claim of distinctiveness was any sort of willful misrepresentation or that applicant was obligated to disclose to the Office its 1981 agreement with opposer regarding the placement of gold stripes on whitewall tires.

Applicant's argument that the prior registration and the 1981 agreement relate to gold bands on the sides of tires irrespective of whether or not they have white sidewalls is illogical. If that were the case, the instant application would have to be refused in order to comply with the Patent and Trademark Office's policy against issuing duplicate registrations. See TMEP 1103.06.


In summary, we find that applicant has not established that a gold band on a blackwall tire is perceived as its trademark, rather than as simply ornamentation. Applicant's use of this feature has been neither extensive nor exclusive. Applicant has not established distinctiveness based on its sales or promotion, or its ownership of a prior registration of the same mark, so registration under the provisions of Section 2(f) of the Act is not appropriate.

Opposition No. 91,352

Accordingly, the opposition is sustained and registration to applicant is refused.

  
J. E. Rice

  
R. L. Simms

  
R. F. Cissel  
Administrative Trademark Judges,  
Trademark Trial & Appeal Board